REMARKS

Claims 1-22 are pending in this application. Claims 3-5 and 22 were amended in order to more clearly define the invention. Support for these amendments can be found in the specification on pages 3-5 and 13-15, for example. Accordingly, no new matter has been added by the forgoing amendments.

Applicants filed an Information Disclosure Statement on October 1, 2001. However, the IDS has not been acknowledged or considered in the Office Action. Applicants respectfully request consideration of the documents listed in that IDS and acknowledgment of that consideration in the next communication.

I. Rejections under 35 U.S.C. § 101

The Examiner rejects claim 22 because the claimed invention is allegedly directed to non-statutory subject matter. The Examiner asserts that the claim "does not sufficiently distinguish over Streptomyces species ST 101396 as it exists naturally because the claim does not particularly points out any non-naturally occurring differences between the claimed product and the naturally occurring products." Applicants respectfully traverse this rejection because no evidence has been provided that this organism occurs naturally. Nonetheless, the amendment to claim 22 renders this rejection moot. For at least these reasons, this rejection is improper and its withdrawal is earnestly solicited.

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Next, the Examiner has rejected claims 1-22 under 35 U.S.C. 101 because the claimed invention is allegedly not supported by either a credible asserted utility or a well established utility. The Examiner admits that the "specification on page 1 states that the claimed compounds have affinity for neurotensin receptors and that some studies have suggested the involvement of neurotensin in schizophrenia, Parkinson's disease and Alzheimer's disease," and "that the claimed compounds are expected to be useful in the treatment of said diseases." The Examiner next assets that these statements are "mere speculation [because] there is no known correlation" between the compounds with affinity for neurotensin receptors and the stated diseases. Office Action pages 2-3. Respectfully, Applicants strongly traverse this rejection.

The courts have held that statements in the disclosure "must be taken as sufficient to satisfy the utility requirement . . . unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope." *In re Langer*, 503 F.2d 1380, 1391-92 (C.C.P.A. 1974) (emphasis in original); MPEP 2107.02 III.A. "It is incumbent upon the Patent Office . . . to explain why it doubts the . . . accuracy of the statement in the supporting disclosure." *In re Marzocchi*, 439 F.2d 220, 223-24 (C.C.P.A. 1971); MPEP 2107.02 III.A. Also, the initial burden is on the Examiner to establish a *prima facie* case for a rejection under § 101; the Examiner "must do more than merely question operability it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability." *In re Gaubert*, 524 F.2d 1222, 1224-25 (C.C.P.A. 1975); MPEP 2107.02.IV.

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Here, the Examiner admits statements are made in the disclosure regarding the utility of the compounds. These statements are credible and must be taken as sufficient and, as explained above, the courts and the MPEP require that the Examiner must do more than "merely question operability." Nonetheless, we present additional evidence, in the concurrently submitted IDS, that provide numerous examples of the well-accepted correlation between the neurotensin receptor and the treatment of the indicated diseases. US Pat. No. 5,430,047 at column 1, lines 20-29, 46-52, column 5, lines 60-67, and column 7, lines 48-65; US Pat. No. 5,250,558 at column 1, lines 30-40, and column 2, lines 44-55; US Pat. No. 5,747,303 at column 6, lines 40-60. In contrast, the Examiner has provided no evidence or scientific reasoning as to why the asserted utility lacks credibility. Thus, the Examiner's conclusory statement of the lack of correlation does not suffice because it does not establish that it is more likely than not that a person skilled in the art would not consider the utility credible. Simply put, the Examiner has provided no evidence to establish a *prima facie* case. For at least these reasons this rejection is improper and its withdrawal is earnestly solicited.

II. Rejections under 35 U.S.C. § 112 first paragraph

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph. The Examiner asserts that claims 1-22 lack a credible utility. The rejection is related to the § 101 rejection above and is traversed for the reasons discussed above. Withdrawal of the rejection is earnestly solicited.

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Next, the Examiner has rejected claims 1-21 under 35 U.S.C. 112, first paragraph, "because the specification, while being enabling for citrullimycines, does not reasonably provide enablement of derivatives of citrullimycines." The Examiner alleges that the "term 'derivatives' encompasses a large number of compounds having different structural formulas and it would take an undue amount of experimentation to determine which specific compounds will be useful in the instant invention." Office Action page 3. Applicants respectfully traverse this rejection.

To determine enablement, the Examiner is required to assess whether one skilled in the art can make or use the invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988); *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993); MPEP 2164.01. The eight Wands factors (sometimes called the Forman factors) are used to assess undue experimentation, and are delineated in MPEP 2164.01(a). *In re Wands*, 858 F.2d 731 *citing In re Forman*, 230 USPQ 546, 547 (Bd. Pat. App & Int. 1986); MPEP 2164.01(a). To conclude a lack of enablement resulting from undue experimentation, the Examiner must not rely on a single factual determination, but must weigh many factual considerations including the Wands factors. *In re Wands*, 858 F.2d at 737; MPEP 2164.01(a). The courts have held that a "considerable amount of experimentation is permissible . . . if the specification provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed." *In re Wands*, 858 F.2d at 737 *citing In re Angstadt*, 537 F.2d 489, 504 (C.C.P.A. 1976); MPEP 2164.06.

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Here, the Examiner has simply asserted that undue experimentation would be required, but has not discussed any of the Wands factors. Thus, the Examiner's rejection has not met the burden set forth by the courts and as instructed by the MPEP. Further, the term "derivatives" is sufficiently defined in the specification on pages 9-10 and numerous examples are provided therein; the disclosure states that such "derivatives" retain the inhibitory activity of the invention. The activity is readily determined using a variety of methods, as demonstrated, for instance, by Example 4 on pages 24-25. Since the specification provides one skilled in the art a reasonable amount of guidance to determine "derivatives" of the compounds within the scope of the claims, there is no undue experimentation. For at least these reasons, the withdrawal of this rejection is earnestly solicited.

Next, the Examiner objects to the specification under 35 U.S.C. 112, first paragraph, because no assurance has been provided that "all restrictions on the availability of this strain will be revoked upon the issuance of a U.S. patent based on this application." Office Action page 3. Applicants traverse this objection. Nonetheless, the Deposit Declaration submitted herewith renders this objection moot. As such, withdrawal of this objection is earnestly requested.

III. Rejections under 35 U.S.C. § 112 second paragraph

The Examiner has rejected claims 1-21 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner

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alleges that the "term 'derivative' (all occurrences) renders the claims indefinite in that it cannot be determined what is encompassed by said terminology." The Examiner further alleges "that the definition of the derivatives set forth in the specification is not limited to esters, ethers, complexes and adducts," as, in part, disclosed on pages 9-10 of the specification. Office Action page 4. Applicants respectfully traverse this rejection.

The MPEP states that "breadth is not to be equated with indefiniteness," and that the definiteness of claim language must be determined in light of, *inter alia*, the applicants' disclosure. MPEP 2173.02; MPEP 2173.04. Here, as discussed above, derivatives according to the invention are those compounds derived from formula (I) that retain the inhibitory activity, as determined, for instance, by Example 4. When read in light of the specification, the term "derivative" clearly defines the metes and bounds of the claims. Thus, withdrawal of this rejection is earnestly solicited.

Next, the Examiner has rejected claims 3-5 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite because the term "comprise" renders the claims indefinite because it leaves the structural formula of the compound open-ended. Office Action page 4. Applicants traverse this rejection. Nonetheless, the claim amendments to claims 3-5 render this rejection moot. Thus, withdrawal of this rejection is earnestly solicited.

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IV. Rejections Under 35 U.S.C. 102 and 103

The Examiner has rejected claim 22 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Grabley et al.* (U.S. Patent

No. 5,252,472) ("*Grabley*") because differences in the claimed species and the prior art species allegedly cannot be determined. Office Action pages 4-5. Applicants respectfully traverse this rejection.

For a claim to be anticipated or obvious, the prior art reference must teach every limitation in the claim. MPEP 2131; MPEP 2143. Here, the Examiner has compared the species of bacteria in *Grabley* to those instantly claimed, but he has failed to address the differences in the strain of the bacteria. Applicants respectfully submit that the strain of the microorganism has been set forth in claim 22. There is no basis for the Examiner to conclude that the claimed strain is found in *Grabley,* because, *inter alia*, the claimed strain is used to prepare molecules different than those prepared by *Grabley*'s strains. For example, the compounds of formula (I) produced by ST101396 of the instant application (for example, page 3 of Applicants' disclosure) are different from those of formula (I) produced by the different strains of *Grabley* (column 1 lines 35-50). Also, Applicants provide the enclosed data table showing differences between the claimed species and *Grabley*'s strains. Thus, Applicants respectfully submit that the PTO has not provided any factual basis to support the conclusion that the instantly claimed strain and those in *Grabley* are the same, or obvious from the strains of *Grabley*. For at least these reasons, withdrawal of these rejections is earnestly solicited.

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V. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

By: Charles E. Van Horn
Charles E. Van Horn
Reg. No. 40,266

Dated: May 5, 2003

Enclosures:
- U.S. Pat. No. 5,747,303
- U.S. Pat. No. 5,250,558
- U.S. Pat. No. 5,430,047
- data table comparing strains

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Accession number	Taxonomical description	Colony color	Spore chain morphology	Spore surface
DSM 4200	Streptomyces fragilis	red	short spirals	smooth
DSM 4211	Streptomyces viridochromogenes	green	spirals	spiky
DSM 4349	Streptomyces cyaneus	blue	spirals	smooth
DSM 4355	Streptomyces spp.	yellow	RF	smooth
DSM 13309	Streptomyces hygroscopicus	grey/black	spirals	rugose